

REMARKS

Amendments

Claim 13 is amended to correct an obvious typographical error. New claims 16-23 are directed to further aspects of applicants' invention. See, e.g., page 7, lines 7-21 and page 9, line 25-page 10, line 1.

Obviousness-Type Double Patenting Rejection

Claims 8-15 are rejected on grounds of obviousness-type double patenting in view of the claims 9-11, 13, 15 and 20 of parent application Serial No. 10/180,072 (allowed).

However, this rejection is respectfully traversed because 35 USC §121 prohibits the use of the parent application against this divisional application (see also MPEP §804). The statute, 35 USC §121, states, among other things, the following:

A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application.

As stated in the Preliminary Amendment filed February 20, 2004, the claim of the instant application are directed to subject matter that was subject to a Restriction Requirement in the parent application. Specifically, in the Office Action of April 25, 2003 (copy enclosed), the Examiner restricted the claims of the parent application into two groups: Group I drawn to a non-aqueous cosmetic material for perspiration control; and Group II drawn to a non-aqueous cosmetic material. In the parent application, applicants elected Group II, cancelled claims directed to the subject matter of Group I, and filed this application with claims drawn to the subject matter of Group I.

Rejection Under 35 USC §103

Claims 9, 13, and 15-18 are rejected as allegedly being obvious under 35 U.S.C. § 103 in view of Powell et al. (US 6,060,546) in combination with Tachibana et al. (US 5,412,004). This rejection is respectfully traversed.

Powell et al. (US '546) discloses a non-aqueous silicone emulsion that comprises a silicone phase and an organic phase. The silicone phase contains a silicone elastomer and a low molecular weight silicone compound. The organic phase comprises an organic liquid.

The silicone elastomer is broadly described in US '546 as containing D structural units and optionally T structural units and/or Q structural units. See column 4, lines 7 - 14. See also the structural units defined at the top of column 2 of US '546. With regards to the silicon elastomer, see also column 4, lines 15-31, and column 5, line 49 - column 7, line 38.

As for the low molecular weight silicone fluid, US '546 discloses that this is an organosilicon compound having a viscosity of below about 1,000 centistokes. See the description of low molecular silicones at column 7, line 39 - column 8, line 3.

The organic liquid used in the emulsion is described at column 15, line 41- column 16, line 8. Examples of organic liquids for use in the organic phase include ethanol, propyl alcohol, isopropyl alcohol, propylene glycol, dipropylene glycol, and glycerin.

US '546 disclose that its emulsion can be used in the preparation of personal care compositions, including, for example, antiperspirants. With regards to antiperspirant compositions, US '546 that disclose that such compositions can contain "one or more active antiperspirant agents, such as, for example, aluminum halides, aluminum hydroxyhalides, for example, aluminum chlorohydrate, and complexes or mixtures thereof with zirconyl oxyhalides and zirconyl hydroxyhalides, such as for example, aluminum-zirconium chlorohydrate." See column 17, lines 9-16.

Tachibana (US '004) discloses a silicone polymer prepared by additional polymerization. The silicone polymer is said to swell in silicone oils and to function as a viscosity increasing agent for silicone oils. See column 2, line 37 - column 3, line 40. In addition, US '004 also describes a paste-like silicone composition which is prepared by combining the silicone polymer with a silicone oil, and kneading the resulted mixture under a

shearing force. See column 3, lines 49-54. This paste-like silicone composition is described as being a medium in which water can be homogeneously stably dispersed.

US '004 also describes a water-in-oil type (W/O) cosmetic composition which comprises the paste-like silicone composition, as part of an oil phase, and at least one water phase component (i.e. water) which is dispersed within the oil phase. Also described are water-in-oil type cosmetic compositions in which the oil phase contains silicic acid anhydride or hydrophobic silica as well as such water-in-oil cosmetic compositions in which the water phase component contains saccharides, sugar alcohols or inorganic salts. See column 3, line 55 - column 4, line 4. US '044 also discloses W/O emulsion cosmetic compositions which contain a polyoxyalkylene-modified organopolysiloxane surfactant, as well as W/O emulsion cosmetic compositions which contain a cosmetic powder. See column 3, line 55-column 4, line 18.

With respect to cosmetic compositions of US '004, these compositions are aqueous compositions, specifically emulsions in which water droplets are dispersed within an oil phase, i.e. water -in-oil emulsion or w/o emulsions. Further, it is noted that with regards to additional components such as silicic acid anhydride, saccharides, sugar alcohols, and cosmetic powders, US '004 describes such additional components in the context of the preparation of the water -in-oil cosmetic composition. See, e.g., column 8, line 53 to column 9 line 45 and column 10 line 57 to column 11, line 62.

In the Examples presented in US '004, the paste-like silicone composition is first prepared by combining the silicone polymer with a silicone oil such as dimethylpolysiloxane, and then kneading the resultant mixture under shearing force. The resultant paste-like silicone composition is then mixed with water.

See also examples 15-32. These examples are directed specifically to cosmetic compositions such as face creams, foundations, eye shadow, hand cream, rouge, and other cream compositions. In each of these examples the compositions are aqueous, that is they contain water. In particular, all of the compositions are w/o type emulsions.

With regards to dispersing of powders and pigments, the rejection points to one specific portion of the disclosure of US '004. A column 7, line 39-45, Tachibana discloses:

This paste-like silicone composition can disperse powders and pigments having specific gravities different from that of silicon oils, and can hold them therein in a stable manner without

precipitating them. Owing to this characteristic, the composition is useful as a base material for creams, cakes, and the like used in cosmetic and quasi-medical products.

While US '004 makes this general description, there is no disclosure in US '004 of any paste-like silicone composition containing powders or pigments dispensed in a stable manner. In the disclosure, the only specific compositions containing dispersed powders or pigments are water-in-oil compositions, i.e., aqueous compositions, not non-aqueous paste-like silicone compositions. Moreover, the only cosmetic compositions specifically described, with or without dispersed powders, are water-in-oil compositions.

Furthermore, this general reference at column 7 to the presence of powders and pigments in a paste-like silicone composition provides no description as to what types of powders or pigments would be suitable, for use therein. There is no mention of water-soluble materials. Moreover, there is no suggestion of aluminum compounds having antiperspirant activity. In addition, this general disclosure does not provide any description or suggestion as to the relative amounts of such pigments or powders that could be stably disperse within the paste-like silicone composition.

In the rejection, it is argued that it would be obvious for one of ordinary skill in the art to modify the non-aqueous cosmetic products of US '546 by using the silicone polymer disclosed by US '004. However, the rejection fails to set forth any motivation as to why one of ordinary skill in the art would look to the aqueous W/O emulsion composition of US '004 for purposes of modifying the non-aqueous compositions of US '546.

It is noted that US '546 distinguishes non-aqueous silicone emulsions from oil-in-water and water-in-oil emulsions of silicones. See, e.g., the text bridging columns 2 and 3. The rejection is devoid of any rationale as to why one of ordinary skill in the art would look to a water-in-oil emulsion disclosure to modify a completely different category of emulsions, i.e., the non-aqueous emulsions of US '546.

The mere ability, in and of itself, to modify the disclosure of a reference does not establish obviousness. Instead, there must be some motivation which would lead one of ordinary skill in the art to make the alleged modification. See, e.g., *In re Laskowski*, 10USPQ2d139.7 (Fed. Cr. 1989) and *In re Kotzab*, 55 USPQ 2d 1313 (Fed Cir. 2000). In the instant case, no motivation is even suggested as to why one of ordinary skill in the art would

ignore the distinguishing comments in US '546 and modify a non-aqueous emulsion based on components disclosed for use in a water-in-oil emulsion.

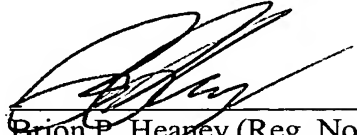
With regards to powders and pigments, US '004 describes such components as talc, kaolin, mica and the like (see column 10, lines 61 - column 11, line 6). These are examples of water in soluble materials. The description in US '004 of dispersing these water insoluble materials within an aqueous composition, i.e., a W/O emulsion composition does not suggest modifying the non-aqueous emulsion disclosure of US '546.

While US '004 makes a general reference to the presence of powders or pigments in a paste-like silicone composition, there is nothing within the disclosure of US '004 which would suggest one with ordinary skill in the art to modify this general description so as to arrive at a composition in accordance with applicant's claimed invention. As noted above, with regards to the presence of pigments and cosmetic powders, the overall disclosure of US '004 suggests incorporation of these materials into water-in-oil cosmetic compositions, not paste-like silicone compositions per se. Furthermore, US '004 provides no disclosure as to what types of powders and pigments can be stably dispersed within the paste-like silicone composition nor what amounts of such materials could be stably dispersed within the paste-like silicone composition. Also, while the disclosure of US '004 at column 7, line 33-45 refers generally to powders and pigments, there is no disclosure of suggestion in the portion of the disclosure with regards to using aluminum compounds exhibiting perspirant control within the paste-like composition.

In view of the above remarks, it is respectfully submitted that the rejection fails to set forth sufficient motivation as to why one of ordinary art would modify the disclosure of US '546 in view of the disclosure of US '004. Thus, it is respectfully submitted that US '546, taken in alone or in combination with US '004 fails to render obvious Applicant's claimed invention. Withdrawal of the rejection under 35 U.S.C. § 103 is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Brion P. Heaney', is written over a horizontal line.

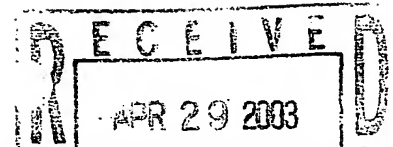
Brion P. Heaney (Reg. No. 32,542)
Attorney for Applicant(s)

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
Arlington Courthouse Plaza 1
2200 Clarendon Blvd., Suite 1400
Arlington, Virginia 22201
Telephone: (703) 812-5308
Facsimile: (703) 243-6410
Internet Address: heaney@mwzb.com

Filed: October 18, 2005



UNITED STATES PATENT AND TRADEMARK OFFICE



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20230
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/180,072 ✓	06/27/2002 ✓	Koji Sakuta	TAKIT-144 D1 ✓	9652

23599 7590 04/25/2003

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

OSTRUP, CLINTON T

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

URGENT

CASE _____
ACTION REST/ELECT. Resp. due
DUE DATE 5/25/03

CASE _____
ACTION _____
DUE DATE 5/25/03
LKI

SKT-D
4/29/03
MDH



Office Action Summary

Application No.

10/180,072

Applicant(s)

SAKUTA, KOJI

Examiner

Clinton Ostrup

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 8-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claims 1-18 are pending in this application.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 8, 10-12, and 14, drawn to a non-aqueous cosmetic material for perspiration control, classified in class 424, subclass 65.
- II. Claims 9, 13, and 15-18, drawn to a non-aqueous cosmetic composition, classified in class 424, subclass 401.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as a lip-gloss. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Art Unit: 1614

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on 8:00am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Clinton Ostrup
Examiner
Art Unit 1614



Frederick Krass
Primary Examiner
Art Unit 1614



April 22, 2003